

REMARKS

By this Amendment, Applicants amend claims 1, 4, 5, and 12. Claims 1-13 are currently pending.

In the Office Action, the Examiner allowed claims 6-11 and 13. The Examiner objected to the title of the invention as not descriptive; rejected claims 1-3 and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,188,904 to Marsan ("Marsan"); and rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Marsan in view of U.S. Patent No. 6,112,089 to Satarasinghe ("Satarasinghe").¹ Applicants thank the Examiner for allowing claims 6-11 and 13. Applicants respectfully traverse the Examiner's rejections under both § 102 and § 103.

Regarding the Objection

Applicants respectfully traverse the Examiner's objection to the title of the invention as not descriptive. However, to expedite the prosecution of this application, Applicants have amended the title of the invention to be more descriptive. Accordingly, Applicants respectfully request withdrawal of the objection to the title of the invention.

Regarding Claim Rejection under 35 U.S.C. § 102

Applicants respectfully traverse the Examiner's rejection of claims 1-3 and 12 under 35 U.S.C. § 102(b) as being anticipated by Marsan. In order to anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1, as amended, recites a combination including, for example, “a circuit configured to select, as a hand-off destination candidate, one station from the first plurality of peripheral base stations indicated in the first neighbor list and the second plurality of peripheral base stations indicated in the second neighbor list, which satisfies a preset condition, based on the measured communication quality.” Marsan fails to disclose at least the claim elements listed above as recited in amended claim 1.

Marsan teaches “a method for improving the communication coverage in multi-cell communication systems which employ neighbor cell lists. The FNE [fixed network equipment] of a particular cell site provides the communication units in its cell with communication and neighbor cell lists.” Marsan, column 2, lines 41-46. In Marsan, “the FNE provides (404) the communication unit 128 in the first cell 112 with communication 116 via cell site 114 including a first neighbor cell list 200 (FIG. 2) with limited entries.” Marsan, column 3, lines 27-31. “When this neighbor cell list update threshold is reached, communication unit 128 has determined a new neighbor cell list is needed. To request a neighbor cell list update, communication unit 128 sends (516) a neighbor cell list update request 132 to the FNE via cell site 114.” Marsan, column 5, lines 20-24, emphasis added. Therefore, Marsan’s teaching of updating a neighbor cell list by only keeping a single neighbor cell list does not constitute a teaching of “a circuit configured to select, as a hand-off destination candidate, one station from the first plurality of peripheral base stations indicated in the first neighbor list and the second plurality of

peripheral base stations indicated in the second neighbor list, which satisfies a preset condition, based on the measured communication quality,” as recited in amended claim 1 (emphasis added).

Therefore, Marsan fails to disclose each and every element of amended claim 1. Marsan thus cannot anticipate claim 1 under 35 U.S.C. § 102. Accordingly, Applicants respectfully request withdrawal of the Section 102 rejection of amended claim 1. Because claims 2 and 3 depend from claim 1, Applicants also request withdrawal of the Section 102 rejection of claim 2 and 3 for at least the same reasons stated above.

Further, independent claim 12, while of different scope, recites similar language to that of claim 1. Claim 12 is therefore also allowable for at least the same reasons as stated above with respect to claim 1. Applicants also respectfully request withdrawal of the Section 102 rejection of claim 12.

Regarding Claim Rejection under 35 U.S.C. § 103

Applicants respectfully traverse the Examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Marsan in view of Satarasinghe. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Claims 4 and 5 depend from claim 1. As set forth above, Marsan fails to teach or suggest at least “a circuit configured to select, as a hand-off destination candidate, one

station from the first plurality of peripheral base stations indicated in the first neighbor list and the second plurality of peripheral base stations indicated in the second neighbor list, which satisfies a preset condition, based on the measured communication quality,” as recited in claim 1 and required by claims 4 and 5.

Satarasinghe fails to cure Marsan’s deficiencies. Satarasinghe discloses “a method and system for increasing capacity and improving performance of a cellular network by improving the conditions for handoff.” Satarasinghe, column 2, lines 9-12. In Satarasinghe, “upon receipt of the PSM message from the mobile unit 14, the BSC 12 determines if the pilot indicated by the PSM message is in the neighbor list (“N_LIST”) 23 for the dominant cell. . . . If at step 22 the PN offset is not in the N_LIST 23, execution proceeds to step 26 in which a pilot consideration matrix is updated, . . . , as the pilot consideration matrix is updated, it can be used to optimize the N LIST 23.” Satarasinghe, column 23-47, emphasis added. However, Satarasinghe’s teaching of updating the neighbor list using a pilot signal by a base station does not constitute “a circuit configured to select, as a hand-off destination candidate, one station from the first plurality of peripheral base stations indicated in the first neighbor list and the second plurality of peripheral base stations indicated in the second neighbor list, which satisfies a preset condition, based on the measured communication quality,” as recited in claim 1 and required by claims 4 and 5 (emphasis added).

Therefore, neither Marsan nor Satarasinghe, taken alone or in any reasonable combination, teaches or suggests all elements required by claims 4 and 5. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103 rejection of claims 4 and 5.

Conclusion

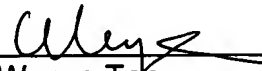
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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